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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,366	07/11/2007	Robert Thompson	16489-55172	3050

24728 7590 05/13/2008
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EXAMINER	
CHERIYAN JR, THOMAS K	
ART UNIT	**PAPER NUMBER**
3714	
MAIL DATE	**DELIVERY MODE**
05/13/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/579,366	THOMPSON ET AL.	
	Examiner	Art Unit	
	THOMAS K. CHERIYAN JR	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. Claim 1 states that a game is stored on a disc with a plurality of discrete chapters where the disc contains a reactive material to limit the length of time said encoded information is available. However, for all games to work, the game usually consists of a main program. If the main program is encoded in the first chapter and the reactive material causes the first chapter to become inoperable after use, then the remaining chapters on the disc will also become inoperable since there is no main program to load the data. Therefore, the invention lacks utility.

Claim 6 is rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. Claim 6 requires that a user to finish a chapter on a CD-ROM before the encoded information becomes unavailable, however, with claim 1 as well as the prior art teaching that that CD-ROM is composed of a reactive material to limit the length of time said encoded information is available, it would be obvious then that a user may go through a chapter on the disc without completing it and if that

chapter is not completed in a certain amount of time, the chapter can become inaccessible because of the reactive material. Therefore, claim 6 is inoperable.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al (US 5815484 A) in view of Kelly et al (US 5816918 A).

Regarding claim 1, Smith discloses a method for distributing video game content comprising:

providing a video game comprising discrete chapters **(Obvious)**; and

providing each discrete chapter on a limited play optical medium, wherein said each limited play optical medium comprises encoded information corresponding to a

particular discrete chapter and a reactive material for limiting the length of time said encoded information is accessible **(Obvious in view of Smith, Abstract and Column 3, Lines 57 through Column 4, Line 4.).**

Regarding claim 2, Smith discloses providing a reward to the end user for each discrete chapter that is provided on a limited play optical medium, and for which the encoded information is no longer accessible, that is returned to a prescribed location **(Obvious in view of Smith, Abstract and Column 3, Lines 57 through Column 4, Line 4.).**

Smith doesn't teach providing a reward after each discrete chapter is completed, however, Kelly et al does **(Kelly, Abstract, Figures 6, A, B, C. Looking at Figure 6, we see that at step 324 when the game is over, a player is awarded with tickets or points to be used to redeem a prize. It would be obvious to award tickets/points to a user after the completion of each discrete chapter. Column 12, Lines 31-67 teaches that the game can be read from a CD-ROM.).**

The motivation for combining the teachings of Kelly with Smith is because Kelly teaches that a game can be implemented and run from a CD-ROM on a computer gaming system. Smith simply teaches that the CD-ROM can be coated with a reactive material so that in a certain amount of time after the disc has been read, the disc will no longer work and therefore, data cannot be read.

Therefore, it would be obvious to anyone skilled in the art of gaming at the time of the invention to combine the teachings of Kelly with Smith because a game developer

can release game discs that will only work for a certain amount of time "naturally" instead of relying on technology to prevent access to content on a disc.

Regarding claim 3, Smith and Kelly discloses reward is a price discount on at least one of a future game or further game chapter **(Kelly, Abstract, Figures 6, A, B, C. It would be obvious that one of the prizes could be a discount on a future game or game chapter.).**

Regarding claims 4 and 5, Smith and Kelly discloses said reward is a special code for unlocking hidden encoded information **(Kelly, Abstract, Figures 6, A, B, C. It would be obvious that one of the prizes to be redeemed by a player would be a code to unlock encoded information or to access a website. Also refer to Column 23, Lines 25-45 which teaches one of the prizes being offered is a code to be redeemed as a discount on beer, but can alternatively be used to unlock encoded information, grant access to a website, etc.).**

Regarding claim 6, Smith and Kelly discloses one of the discrete chapters requires a user to finish the chapter before said encoded information becomes inaccessible in order to move on to the next chapter **(Obvious, since the user once accessing the discrete chapter "activates" the reactive material on the disc and is therefore forced to finish the chapter before the encoded information becomes unavailable.).**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas K. Cheriyan whose telephone number is 571-270-3225. The examiner can normally be reached on Mon-Fri 7:30AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert E Pezzuto/

Supervisory Patent Examiner, Art Unit 3714